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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,353	12/01/2000	Joel Arberman	3977-4006	4123

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EXAMINER

HECK, MICHAEL C

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/728,353

Applicant(s)

ARBERMAN, JOEL

Examiner

Michael Heck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. The following is a First Office Action in response to the application filed 01 December 2000. Claims 1-50 are pending in this application and have been examined on the merits as discussed below.

Drawings

2. The drawings are objected to because reference character 150 in box 160 of Figure 1A should be reference character 165 as identified in the specification on page 12, lines 10-16. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities:

- On page 12, line 3, delete “The CPU 140”, and insert -- The CPU **150** --.

The above citation is a mere guide. Applicant is requested to review the specification thoroughly to eliminate additional errors.

Claim Objections

4. Claim 35 is objected to because of the following informalities: delete “The method of claim 34”, and insert -- The **system** of claim 34 --. Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claim 1-11 and 34-40** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences,

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for example) and therefore are found to be non-statutory subject matter. For the process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, claims **1-11 and 34-40** only recites an abstract idea.

As to **claim 1**, the recited steps of collecting information from one or more business partners; organizing the collected information into distinct categories; receiving a search request from a user; transmitting information to the user in accordance with the search request; and updating statistics on user usage to reflect the search request by the user does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. The method only constitutes an idea for content recognition, therefore, is deemed to be directed to non-statutory subject matter.

As to **claim 6**, the recited steps of collecting information from one or more business partners; organizing the collected information into distinct categories; receiving a request from a user to access information on a selected topic; making available information on the selected topic to the user; and updating statistics on user usage to reflect the access information does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. The method only constitutes an idea for content recognition, therefore, is deemed to be directed to non-statutory subject matter.

As to **claim 34**, the recited means for collecting information from one or more business partners; means for organizing the collected information into distinct categories; means for receiving a search request from a user; means for transmitting information to the user in accordance with the search request; and means for updating statistics on user usage to reflect the search request by the user does not apply, involve, use, or advance the technological arts since all

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of the recited means can be performed in the mind of the user or by use of a pencil and paper. The system only constitutes an idea for content recognition, therefore, is deemed to be directed to non-statutory subject matter.

As to **claim 36**, the recited means for collecting information from one or more business partners; means for organizing the collected information into distinct categories; means for receiving a request from a user to access information on a selected topic; means for making available information on the selected topic to the user; and means for updating statistics on user usage to reflect the access information does not apply, involve, use, or advance the technological arts since all of the recited means can be performed in the mind of the user or by use of a pencil and paper. The system only constitutes an idea for content recognition, therefore, is deemed to be directed to non-statutory subject matter.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implications of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps are directed to anything in the technological arts as explained above. Looking at the claim as a whole, nothing in the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces content recognition (i.e., repeatable, useful and tangible).

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Looking at the claims as a whole, nothing in the body of the claims recite any structure or functionality to suggest that a computer performs a task. Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, the same rejection as stated above for claims 1, 6, 34, and 36 applies to **claims 2-5, 7-11, 35, and 37-40**.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

8. **Claims 1-50** are rejected under 35 U.S.C. 102(e) as being anticipated by Gerace (U.S. Patent 5,848,396). Gerace discloses a system and method for content recognition over the internet comprising:

- [**Claim 1**] collecting information from one or more business partners (col. 4, lines 44-47, Gerace teaches an advertisement module that holds sponsor information and their advertisements, with a target audience profile indicated for each advertisement.);
- organizing the collected information into distinct categories (col. 1, lines 8-10 and col. 4, lines 4-6, Gerace teaches agate information is used to refer to time-sensitive, reference information that is not read linearly. During the user's first visit, the initial screen view provides menu selection of various agate information (e.g., stock market data, weather, sports, etc.). The examiner interprets the information is organized into distinct categories.);
- receiving a search request from a user (col. 4, lines 7-11, Gerace teaches that upon user selection of a menu item, the program displays corresponding up-to-date information. Similarly, each time the user selects another menu item, the program generates and displays current agate information relating to that selection.);
- transmitting information to the user in accordance with the search request (col. 4, lines 7-9, Gerace teaches that upon user selection of a menu item, the program displays corresponding up-to-date information. Similarly, each time the user selects

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another menu item, the program generates and displays current agate information relating to that selection.); and

- updating statistics on user usage to reflect the search request by the user (col. 4, lines 12-29, Gerace teaches the program records the user's selection, and their viewing activity with respect to the agate information. After multiple sessions, a pattern of the user's viewing actions or viewing habits is obtained, from the recorded activity.).
- [**Claim 2**] creating segments of usage patterns, where said usage patterns are created based on the statistics on user usage by a plurality of users (col. 2, lines 3-15, Gerace teaches the system provides a tracking and profiling member for recording user activity with respect to agate information displayed through the data assembly. Over time, the tracking and profiling member holds a history and/or pattern of user activity that in turn is interpreted as a user's habit and/or preferences. To that end, a psychographics profile is inferred from the recorded activities in the tracking and profiling member.).
- [**Claim 3**] storing all information regarding the search request made by the user and the information transmitted to the user (col. 2, lines 54-60, Gerace teaches the User Object utilizes an updating routine that maintains the history profiling table by storing an indication of user's actions with respect to displayed agate information).
- [**Claim 4**] data mining the stored information to better customize the information being transmitted to the user (col. 13, lines 9-33, and col. 14, line 66 to col. 15, line 44, Gerace teaches a Demographic Response Rates Report where all ad packages of a sponsor are compared. The ad success by the sponsor-targeted demographic groups is compared by calculating a regression on the targeted demographic groups for the ads. The results of the regression calculation are used to suggest other demographic characteristics that are important factors in the number of click throughs and/or number of purchases. Specifically, the program tracks demographic and /or psychographics criteria of users who view ("hit") and/or select (i.e., "click through") advertisements. The program performs a traditional regression analysis of the tracked criteria, which results in null and alternative hypothesis testing to determine significance (t-test or χ^2 test) of criteria/variables and in squared correlation and squared correlation testing (R^2) to determine the weight of each criteria.).
- [**Claim 5**] comprising transmitting non-requested information to the user, wherein the non-requested information is similar to the information transmitted to the user in response to the search request (col. 2, line 27-29 and col. 4, lines 30-47, Gerace teaches the advertisements are displayed to users in accordance with the psychographics profile of the user. Based on the created user profile for a given user, the program enables sponsors to better direct their advertisements. The advertisement module holds sponsor information and their advertisements, with a target audience profile indicated for each advertisement.).

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- [**Claim 6**] collecting information from one or more business partners (col. 4, lines 44-47, Gerace teaches an advertisement module that holds sponsor information and their advertisements, with a target audience profile indicated for each advertisement.);
- organizing the collected information into distinct categories (col. 1, lines 8-10 and col. 4, lines 4-6, Gerace teaches agate information is used to refer to time-sensitive, reference information that is not read linearly. During the user's first visit, the initial screen view provides menu selection of various agate information (e.g., stock market data, weather, sports, etc.). The examiner interprets the information is organized into distinct categories.);
- receiving a request from a user to access information on a selected topic (col. 4, lines 7-11, Gerace teaches that upon user selection of a menu item, the program displays corresponding up-to-date information. Similarly, each time the user selects another menu item, the program generates and displays current agate information relating to that selection.);
- making available information on the selected topic to the user (col. 4, lines 7-9, Gerace teaches that upon user selection of a menu item, the program displays corresponding up-to-date information. Similarly, each time the user selects another menu item, the program generates and displays current agate information relating to that selection.); and
- updating statistics on user usage to reflect the access information (col. 4, lines 12-29, Gerace teaches the program records the user's selection, and their viewing activity with respect to the agate information. After multiple sessions, a pattern of the user's viewing actions or viewing habits is obtained, from the recorded activity.).
- [**Claim 7**] said access information comprises request for access to libraries of information on one or more topics (col. 1, lines 8-10 and col. 4, lines 4-6, Gerace teaches agate information is used to refer to time-sensitive, reference information that is not read linearly. During the user's first visit, the initial screen view provides menu selection of various agate information (e.g., stock market data, weather, sports, etc.).).
- [**Claim 12**] launching content recognition software on a personal computer (col. 2, lines 6-8 and col. 3, line 57-62, Gerace teaches providing a data assembly for displaying customized agate information to a computer user. The software program is operated on and connected through a server to the Internet for communication among the various networks and/or processors and other end users connected through respective servers.);
- receiving a user profile from a user (col. 2, lines 9-14, Gerace teaches a tracking and profiling member for recording user activity with respect to agate information

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displayed through the data assembly. Over time, the tracking and profiling member holds a history and/or pattern of user activity, which in turn is interpreted as a user's habits and /or preferences. To that end, a psychographics profile is inferred from the recorded activities in the tracking and profiling member.);

- transmitting the user profile and the list of interest to a server for data collection (col. 2, lines 3-15 and col. 4, lines 12-29, Gerace teaches the system provides a tracking and profiling member for recording user activity with respect to agate information displayed through the data assembly. Over time, the tracking and profiling member holds a history and/or pattern of user activity that in turn is interpreted as a user's habit and/or preferences. To that end, a psychographics profile is inferred from the recorded activities in the tracking and profiling member. The program records the user's selection, and their viewing activity with respect to the agate information. After multiple sessions, a pattern of the user's viewing actions or viewing habits is obtained, from the recorded activity.);
- transmitting information to the user in accordance with the user profile and interests (col. 2, line 27-29 and col. 4, lines 30-47, Gerace teaches the advertisements are displayed to users in accordance with the psychographics profile of the user. Based on the created user profile for a given user, the program enables sponsors to better direct their advertisements. The advertisement module holds sponsor information and their advertisements, with a target audience profile indicated for each advertisement.);
- compiling statistics based on the user profile and the list of interests (col. 4, lines 12-29, Gerace teaches the program records the user's selection, and their viewing activity with respect to the agate information. After multiple sessions, a pattern of the user's viewing actions or viewing habits is obtained, from the recorded activity.); and
- creating a plurality of libraries on different topics, said libraries created based on the compiled statistics (col. 4, lines 11-29, Gerace teaches that after multiple sessions, a pattern of the user's viewing actions or viewing habits is obtained, from the recorded activity. The system then generates a custom Home Page, including user's preferred (content and presentation) agate information.).
- **[Claim 13]** the server develops a list of interests based on the user profile (col. 4, lines 11-29, Gerace teaches that after multiple sessions, a pattern of the user's viewing actions or viewing habits is obtained, from the recorded activity. The system then generates a custom Home Page, including user's preferred (content and presentation) agate information.).
- **[Claim 47]** launching content recognition software on a computer, wherein the content recognition software includes a data recognition algorithm that runs when the content recognition software is launched (col. 2, lines 6-8 and 56-67, col. 3, line 57-62, and col. 4, lines 50-67, Gerace teaches providing a data assembly for displaying

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customized agate information to a computer user. The software program is operates on and is connected through a server to the Internet for communication among the various networks and/or processors and other end users connected through respective servers. The program controller assigns a unique users computer ID upon user login. In response to user login, the program controller checks with the user profiling member to obtain preference information for that user and using agate information generates an initial screen view formatted according to the user's recorded preferences.);

- registering the content recognition software with a service provider (col. 3, lines 39-67, Gerace teaches a plurality of networks where each network includes a multiplicity of digital processors loosely coupled to a host processor or server for communication among the processors within that network. Also linked to the communications lines are various servers that provide to end users access to the Internet. The software program is operates on and is connected through a server to the Internet for communication among the various networks and/or processors. Inherently, an Internet Service Provider is used to provide users access to the Internet.);
- transmitting a user profile to the service provider (col. 4, lines 23-29 and 50-67, Gerace teaches the system generates a custom Home Page, including a users preferred agate information, On subsequent visits to the program , such as a website, by the user, the program displays the customized home page for the user instead of the initial Home Page. The program controller assigns a unique users computer ID upon user login. In response to user login, the program controller checks with the user profiling member to obtain preference information for that user and using agate information generates an initial screen view formatted according to the user's recorded preferences. The examiner interprets the initial screen to be the custom Home Page.);
- receiving information from the service provider in accordance with the user profile (col. 4, lines 7-9, Gerace teaches that upon user selection of a menu item, the program displays corresponding up-to-date information. Similarly, each time the user selects another menu item, the program generates and displays current agate information relating to that selection.); and
- selecting desired content from the received information (col. 2, line 61 to col. 3, line 3, Gerace teaches the agate information includes stock information, advertisements, sports statistics, weather reports and the like. With regard to stock information, an Agate Object routine receives stock data online, parses the data and makes a value-added calculation. The examiner interprets the desired content from the received information is used to make the calculations.).
- **[Claim 48]** the service provider identifies the user based on said data recognition algorithm (col. 4, lines 50-67, Gerace teaches The program controller assigns a unique users computer ID upon user login. In response to user login, the program

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controller checks with the user profiling member to obtain preference information for that user and using agate information generates an initial screen view formatted according to the user's recorded preferences.)

Claims 8-11, 14-46, and 49-50 substantially recites the same limitations as that of claims 1-7, 12 and 13 with the distinction of the recited method being a method, system, and a computer device. Hence the same rejection for claims 1-7, 12 and 13 as applied above applies to claims 8-11, 14-46 and 49-50.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Heck whose telephone number is (703) 305-8215. The examiner can normally be reached Monday thru Friday between the hours of 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R. Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

**Director of the United States Patent and Trademark Office
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Or faxed to:

(703) 872-9306	[Official communications; including After Final communications labeled " Box AF "]
(703) 746-9419	[Informal/Draft communication, labeled " PROPOSED " or " DRAFT "]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, Virginia, and the 7th floor receptionist.

mch
14 June 2004


**TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600**